UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
VU, THONG H

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	09/707,140	AHO, OUTI
	Examiner	Art Unit	
	Thong H. Vu	2619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>01 July 0908</u>.
2a)☐ This action is **FINAL**.　　　　2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-4,7-11,15,17,35,36,38-40,42-44,47-51 and 53-61</u> is/are pending in the application.
　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-4,7-11,15,17,35,36,38-40,42-44,47-51 and 53-61</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
　　a)☐ All　b)☐ Some * c)☐ None of:
　　　1.☐ Certified copies of the priority documents have been received.
　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.
　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)
1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☒ Information Disclosure Statement(s) (PTO/SB/08)
　　Paper No(s)/Mail Date <u>7/08</u>.
4)☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

1.   Claims 1-4,7-11,15,17,35-36,38,39-40,42-44,47-51,53-61 are pending.

Continued Examination Under 37 CFR 1.114

2.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/09/08

has been entered.

Double Patenting

3.   The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
unjustified or improper timewise extension of the "right to exclude" granted by a patent
and to prevent possible harassment by multiple assignees.   A nonstatutory
obviousness-type double patenting rejection is appropriate where the conflicting claims
are not identical, but at least one examined application claim is not patentably distinct
from the reference claim(s) because the examined application claim is either anticipated
by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140
F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29
USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.
1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422
F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163
USPQ 644 (CCPA 1969).
        A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d)
may be used to overcome an actual or provisional rejection based on a nonstatutory
double patenting ground provided the conflicting application or patent either is shown to
be commonly owned with this application, or claims an invention made as a result of
activities undertaken within the scope of a joint research agreement.
        Effective January 1, 1994, a registered attorney or agent of record may sign a
terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with
37 CFR 3.73(b).

        Claims 1-4,7-11,15,17,35-36,38,39-40,42-44,47-51,53-61 are rejected on the

ground of nonstatutory double patenting over claims 1-13 of U. S. Patent No. 6,678,361

B2 ('361) since the claims, if allowed, would improperly extend the "right to exclude"

already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the

patent and is covered by the patent since the patent and the application are claiming

common subject matter, as follows:

('361) 7. A method for delivering messages in a communication network consisting of at least one terminal and a multimedia messaging service center, said method comprising the steps of receiving a message (MM) for said terminal (MS) by said multimedia messaging service center (MMSC);	(Application) 1. A method comprising Receiving and storing a multimedia message; retrieving information about properties of a wireless terminal from a user profile for the wireless terminal stored in the server; and
said multimedia messaging service center receiving capability information concerning the capabilities of the terminal from said terminal, the capability information being capable of indicating codecs supported by said terminal;	identifying by said server at least one component of the multimedia message which the wireless terminal can handle according to the retrieved properties of the wireless terminal can handle according to the retrieved properties of the wireless terminal; transmitting the at least one component and transmitted to the wireless terminal.
sending a notification that notifies about the presence of said message from said multimedia messaging service center to said terminal, the notification containing information describing the properties of the message;	4. ... wherein transmitting a notification message to the wireless terminal comprising information about at least one property of said at least one multimedia component.
deciding by said terminal based on its capabilities, current user profile and the properties of the message provided by the notification how said received message should be handled;	8. . wherein said information on the properties of the wireless terminal comprises information on the capability of the wireless terminal to process multimedia components of a particular type.
replying by said terminal to the notification sent by said multimedia messaging service center, therewith instructing said multimedia messaging service center according to the result of said decision step; and	
handling said message by said multimedia messaging service center according to said instructions.	

It's clearly that the invention taught a method for delivery a multimedia message from

server to client based on the user profile and property information wherein the

information was hardware /device or software /message as well as the capacity of

device or capability of software as a design choice and the notification is sent according

the result. The process of identifying the multimedia message can be handled by the

terminal ('361) or by the server (current application) as a design choice or

rearrangement which is unpatentable. See *In re Japikse, 181 F.2d 1019, 86 USPQ 70*

(CCPA 1950).

Claim Rejections - 35 USC § 103

Claims 1-4,7-11,15,17, 35-42, 43-44,47-51, 53-54, 55-59, 60-61 are rejected

under 35 U.S.C. 103(a) as being unpatentable over Bull et al [Bull 5,901,287] in view of

Theimer et al [Theimer 5,544,321].

Claim 1, Bull discloses A method comprising

receiving and storing a multimedia message retrieving information (about

properties of a wireless terminal) from a user profile for the wireless terminal stored in

the server [Bull, mobile devices, PDA, information retrieval and display, interactive

multimedia, col 4 lines 6-15; user profile, col 7line 47;col 8 line 64;col 10 line 35; col 12

line 1]; and

identifying by said server at least one component of the multimedia message

which the wireless terminal can handle according to the retrieved information (properties

of the wireless terminal) [Bull, a network provider or server, col 3 line 31; col 6 line 55;

excess capacity, the threshold is met and if satisfactory, col 7 lines 1-10];

transmitting <u>the at least one component</u> and transmitted to the wireless terminal [Bull, email system, col 11 lines 28-32].

However Bull does not explicitly detail the retrieved information as properties of the wireless terminal.

Theimer taught a network environment including a server, mobile communication [Theimer, col 5 lines 59-67]; wireless media [Theimer, col 6 line 49], notifies about change [Theimer, col 9 lines 28-41]; scheduled [Theimer, col 10 line 59]; the user profile may specify customization the properties for the device [Theimer, col 27 lines 15-26].

Therefore it would have been obvious to an ordinary skill in the art at the time the invention was made to incorporate the user profile including the property of mobile device as taught by Theimer into the Bull's apparatus in order to utilize the electronic message processing.

Doing so would provide efficient and intuitive manner to delivery the multimedia message to the wireless devices over internet.

4.   Claim 2, Bull discloses at least one bearer for transmission of the at <u>least one</u> component of the multimedia message <u>based on the type of content of the at least one</u> <u>component</u> [Bull, ad/coupon, col 10 line 57].

5.   Claim 3, Bull discloses the selection of at least one bearer is performed in the wireless terminal as inherent feature of mobile device.

6.   Claim 4, Bull discloses transmitting a notification message to the wireless
terminal comprising information about at least one property of said at least one
multimedia component [Bull, notifies, col 8 line 35].

7.   Claim 7, Bull discloses said information on the properties of the wireless terminal
comprises information on the available storage capacity of the wireless terminal [Bull,
excess capacity, the threshold is met and if satisfactory, col 7 lines 1-10].

8.   Claim 8, the combination of Bull and Theimer discloses said information on the
properties of the wireless terminal comprises information on the capability of the
wireless terminal to process multimedia components of a particular type [Theimer, the
user profile may specify customization the properties for the device, col 27 lines 15-26].

9.   Claim 9, the combination of Bull and Theimer discloses the capability of the
wireless terminal to process multimedia components is defined on the basis of the
hardware properties of the wireless terminal and / or the properties of the programs
installed in the wireless terminal [Bull, particular advertisement, col 13 line 40] and
[Theimer, specify preferred customization properties, col 27 line 25-30].

10.   Claim 10, Bull discloses a maximum time of validity is defined for the information
on the properties of the wireless terminal stored in said server as inherent feature of
client-server relationship.

11.   Claim 11, Bull discloses transmitting a notification message to the wireless
terminal to indicate that a multimedia message has arrived at the server; wherein the
notification further comprises a request to update the properties of the wireless terminal;
receiving and storing information to update the properties of the wireless terminal

terminal stored <u>at</u> the server [Bull, network provider or server, col 3 line 31; col 6 line 55; mobile device, col 4 line 12; notifies, col 8 line 35; update, col 7 line 23].

12.   Claim 15, Bull discloses a WAP terminal is used as a wireless terminal and that a multimedia message service centre is used as a server [Bull, network provider or server, col 3 line 31; col 6 line 55; mobile device, col 4 line 12].

13.   Claim 17, Bull discloses the at least one components of the multimedia message is transmitted without <u>receiving</u> a transmission request from the wireless terminal [Bull, email message, col 11 line 28].

14.   Claim 53, Bull discloses receiving a Uaprof information (i.e.: user agent profile) transmission message about the properties of the wireless terminal as inherent feature of email message.

15.   Claim 54, Bull discloses the Uaprof information transmission message is formed in accordance with WAP specifications as inherent feature of email message.

16.   Claim 43, Bull discloses A wireless terminal comprising:

        <u>a receiving element for receiving a notification message to indicate receipt of a multimedia message at a server</u> [Bull, network provider or server, col 3 lines 20-41; multimedia, col 4 line 15; notifies, col 8 line 35];

        transmitting a request to <u>the server for transmission of at least</u> one component of the multimedia message [Bull, specific request, col 12 lines 40].

Bull also taught the software agents for search and insert advertise/coupon [Bull,

col 10 lines 45-67] and access capacity, when the threshold is met and if satisfactory

[Bull, col 7 lines 1-10].

However Bull does not explicitly detail the request including a component of

message without identifying the component which the wireless terminal is able to

process.

Theimer taught a network environment including a server, mobile communication

[Theimer, col 5 lines 59-67]; wireless media [Theimer, col 6 line 49], notifies about

change [Theimer, col 9 lines 28-41]; scheduled [Theimer, col 10 line 59]; the user profile

may specify customization the properties for the device [Theimer, col 27 lines 15-26].

Therefore it would have been obvious to an ordinary skill in the art at the time the

invention was made to incorporate the user profile including the property of mobile

device in the request without identifying the component as taught by Theimer into the

Bull's apparatus in order to utilize the electronic message processing.

Doing so would provide efficient and intuitive manner to delivery the multimedia

message to the wireless devices over internet.

17.   Claim 44, Bull discloses the wireless terminal is configured to select at least one

bearer for transmission of at least one component of the multimedia message based on

the type of content of the at least one component [Bull, a variety of means: facsimile.

Email, text page, voice pager, col 5 lines 50-55].

18.   Claim 47, Bull discloses said information on the properties of the wireless

terminal comprises information on the available storage capacity available of the

wireless terminal [Bull, access capacity, when the threshold is met and if satisfactory,

col 7 lines 1-10].

19.   Claim 48, the combination of Bull and Theimer discloses said information on the

properties of the wireless terminal comprises information on the capability of the

wireless terminal to process multimedia components of a particular type [Bull, particular

advertisement, col 13 line 40] and [Theimer, specify preferred customization properties,

col 27 line 25-30].

20.   Claim 49, the combination of Bull and Theimer discloses the capability of the

wireless terminal to process multimedia components is specified on the basis of the

hardware properties of the wireless terminal and / or on the basis of the properties of

the programs installed in the wireless terminal [Theimer, specify preferred customization

properties, col 27 line 25-30].

21.   Claim 50, Bull discloses the wireless terminal is configured to transmit

information on the properties of the wireless terminal to the server in response to a

property information update request in the notification message [Bull, notifies, col 8 line

35; updating, col 8 line 64].

22.   Claim 51, Bull discloses characterized in that the wireless terminal is a WAP

terminal as inherent feature of mobile device.

23.   Claim 60, Bull discloses the request includes information to retrieve a Uaprof

information as inherent feature of email message.

24.   Claim 61, Bull discloses the wireless terminal is configured to form the Uaprof

information transmission message in accordance with WAP specifications as inherent

feature of email message.

25.   Claim 35, Bull discloses A server for multimedia messaging service comprising:

a receiving element for receiving a multimedia message [Bull, multimedia, col 4 line 15];

a data storage for storing a user profile (comprising information on properties of a

wireless terminal) [Bull, user profile, col 4 line 26];

determining at least one component of the multimedia message which the wireless

terminal can handle according to the retrieved information and a transmitting element

for transmitting to the wireless terminal the at least one component of the multimedia

message [Bull, excess capacity, the threshold is met and if satisfactory, col 7 lines 1-10;

email system, col 11 lines 28-32].

        However Bull does not explicitly detail a user profile including the properties of

the wireless terminal and a control unit for retrieving information about properties of the

wireless terminal stored in the data storage;

        Theimer taught a network environment including a server, mobile communication

[Theimer, col 5 lines 59-67]; wireless media [Theimer, col 6 line 49], notifies about

change [Theimer, col 9 lines 28-41]; scheduled [Theimer, col 10 line 59]; the user profile

may specify customization the properties for the device [Theimer, col 27 lines 15-26].

        Therefore it would have been obvious to an ordinary skill in the art at the time the

invention was made to incorporate the user profile including the property of mobile

device in the request without identifying the component as taught by Theimer into the

Bull's apparatus in order to utilize the electronic message processing.

Doing so would provide efficient and intuitive manner to delivery the multimedia

message to the wireless devices over internet.

26.   Claim 36, Bull discloses the server is configured to comprises transmit a

notification message to the wireless terminal comprising information about at least one

property of said at least one multimedia component [Bull, notifies, col 8 line 35].

27.   Claim 38, Bull discloses a maximum time of validity is specified for said

information on at least one property of the wireless terminal stored in said server [Bull,

specific request, col 12 line 39].

28.   Claim 39, Bull discloses the server is further configured to transmit a notification

message to the wireless terminal to indicate that a multimedia message has arrived

[Bull, notifies, col 8 line 35], the notification message further comprises a request to

update the properties of the wireless terminal and to receive and store information to

update the properties of the wireless terminal at the data storage [Bull, profile updating,

col 8 line 64].

29.   Claim 40, Bull discloses the server is configured to examining the validity of said

property information of the wireless terminal stored in said data storage, and request to

update the properties of the wireless terminal in said notification message [Bull, update

the index datastore, col 7 lines 22-30].

30.   Claim 42, Bull discloses characterized in that it is a multimedia message service centre [Bull, network provider or server, col 3 lines 25-41].

31.   Claim 55, Bull discloses the server is configured to transmit at least one component of the multimedia message to the wireless terminal without receiving from the wireless terminal an identification of the at least one component which the wireless terminal is able to process [Bull, software agent advertising insertion, col 4 line 63].

32.   Claim 56, Bull discloses the server is configured to transmit the at least one component of the multimedia message without receiving a transmission request from the wireless terminal [Bull, email message, col 11 line 28].

33.   Claim 57, Bull discloses said information about the properties of the wireless terminal includes information about the available memory of the wireless terminal [Bull, excess capacity, col 7 lines 3].

34.   Claim 58, the combination of Bull and Theimer discloses said information about the properties of the wireless terminal includes information about the capability of the wireless terminal to process a certain type of component [Theimer, the user profile may specify customization the properties for the device, col 27 lines 15-26].

35.   Claim 59, the combination of Bull and Theimer discloses the capability of the wireless terminal to process a certain type of component is defined by at least one of the following: hardware properties of the wireless terminal, software properties of the wireless terminal, software properties of an accessory device attached to the wireless terminal [Theimer, the user profile may specify customization the properties for the device, col 27 lines 15-26].

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong H. Vu whose telephone number is 571-272-3904. The examiner can normally be reached on 6:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jay Patel can be reached on 571-272-2988. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thong H Vu/
Primary Examiner, Art Unit 2619